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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 01-1096)

In re Application of:)	
)	
Fritz et al.)	Examiner S. Chunduru
)	
Serial No.)	
09/780,206)	
)	
Filed:)	Group Art Unit:1656
February 9, 2001)	
)	
For:)	
System for Simple Nucleic)	
Acid Analysis)	

Assistant Commissioner for Patents
Washington, D.C. 20231

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RESPONSE TO RESTRICTION REQUIREMENT

In response to the Restriction Requirement mailed January 14, 2002, Applicants elect Group I, claims 36-41, with traverse.

The Examiner has restricted the claims of the application based upon the Examiner's interpretation that the claims are directed to a product (groups I and III) and a process of using the product (group II). Accordingly, in order for the restriction to be proper, the burden is on the Examiner to provide an example of (A) the process of using as claimed practiced with another materially different product; or (B) a new product as claimed used in a materially different process. According to the Examiner, the product as claimed in Group I¹ can be used in purification assays or hybridization assays. The method claims of Group II (claims 42-67) are, in fact, directed to such purification or hybridization assays. For example, claims 42-53 are directed to methods of detecting nucleic acids including the detection of amplification products (hybridization assays). In addition, claims 61-67 are directed to a method of isolating (purifying) nucleic acids

¹ The Examiner refers to Group II in the paragraph in the middle of page 2 of the Office Action, Applicants believe this should read Group I.

CERTIFICATE OF MAILING (37 C.F.R. 1.8a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the: Commissioner for Patents, Washington D.C. 20231, on June 13, 2002.

Date: June 13, 2002

[Signature]

from a microorganism. Thus, the methods identified by the Examiner are not alternative uses of the apparatus. (See MPEP § 806.05 (h)).

Furthermore, Applicants respectfully submit that a thorough search of the claims of Group I along with the claims of Group II would not place a serious additional burden on the Examiner. MPEP § 803 states that a requirement for restriction is only permitted if both of the following criteria are met: (1) the purported inventions must be patentably distinct or independent, or (2) there must be a serious burden on the Examiner if the restrictions are not required.

Applicants respectfully submit that there would be no serious additional burden on the Examiner if the claims of Group II were examined along with those of Group I. The Examiner has not shown such burden by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined by MPEP § 808.02. Applicants respectfully submit that if the Office cannot indicate why there would be a serious additional burden on the Examiner, the Office should withdraw the Restriction Requirement and examine all the claims of Groups I and II together in this application.

If the Examiner is of the opinion that a telephone conference would expedite prosecution of the application, Examiner is invited to contact Applicant's undersigned representative.

Date: 6-13-02

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Respectfully submitted,

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